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Legal Office

In re Application of:
LI, Xiaonan, et al.
Application No.: 10/954,134
Filing Date: None Assigned
Attorney Docket No.: NREL 01-43
For: METHOD FOR PRODUCING HIGH
CARRIER CONCENTRATION P-
TYPE TRANSPARENT
CONDUCTING OXIDES

DECISION ON PETITION UNDER
37 CFR 1.182

This decision is issued in response to the "Petition To Convert A Filing Under 37 CFR 1.53(b) To 35 U.S.C. 371" filed March 28, 2005, treated herein under 37 CFR 1.182. Applicant has paid the required petition fee.

BACKGROUND

On April 02, 2002, applicants filed international application PCT/US02/11104 which claimed a priority date of August 17, 2001 and which designated the United States. The deadline for submission of the basic national fee was thirty months from the priority date, i.e., February 17, 2004.

On September 22, 2004, applicants initiated the present U.S. application by filing a "Utility Patent Application Transmittal" (Form PTO/SB/05), accompanied by a "Transmittal Letter To The United States Designated/Elected office (DO/EO/US) Concerning A Filing Under 35 U.S.C. 371" (Form PTO-1390), a declaration, an Information Disclosure Statement (IDS), and an authorization to charge Deposit Account No. 14-0460 for required fees. The Form PTO/SB/05 Transmittal Letter used by applicant specifically states that it is for use "[o]nly for new nonprovisional application under 37 CFR 1.53(b)." However, the Form PTO-1390 Transmittal Letter identifies the submission as a national stage filed under 35 U.S.C. 371 of international application PCT/US02/11104.

On March 15, 2005, the USPTO mailed a "Notice Of Incomplete Nonprovisional Application Filed Under 37 CFR 1.53(b)" indicating that the submission had been treated as a filing under 35 U.S.C. 111(a) and 37 CFR 1.53(b). The Notice informed applicants that the submission had not been assigned a filing date because it did not include a specification or at least one claim. The Notice stated that the required materials had to be filed within two months of the mail date of the Notice and that the failure to submit these materials in a timely manner would result termination of proceedings on the application.

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On March 28, 2005, applicants filed the "Petition To Convert A Filing Under 37 CFR 1.53(b) To 35 U.S.C. 371" considered herein. The petition states that the inclusion of the Form PTO/SB/05 Transmittal Letter in the September 22, 2004 submission was an error. Applicants therefore request that the September 22, 2004 submission be treated as a national stage filing under 35 U.S.C. 371.

DISCUSSION

Any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions set forth in 35 U.S.C. 371(c). See 37 CFR 1.495(g):

The documents and fees submitted ... must be clearly identified as a submission to enter the national stage under 35 U.S.C. 371, otherwise the submission will be considered as being made under 35 U.S.C. 111.

In addition, section 1893.03(a) of the MPEP states the following:

If there are any conflicting instructions as to whether the filing is under 35 U.S.C. 111(a) or 35 U.S.C. 371, the application will be accepted as filed under 35 U.S.C. 111(a).

As noted above, applicant's September 22, 2004 filing included both a Form PTO/SB/05 Transmittal letter (for use "[o]nly for new nonprovisional application under 37 CFR 1.53(b)") and a Form PTO-1390 Transmittal Letter (for use only with national stage filings under 35 U.S.C. 371). The inclusion of these two transmittal letters constitutes "conflicting instructions" which, pursuant to the MPEP, requires that the application be treated under 35 U.S.C. 111(a). Accordingly, the original papers deposited on September 22, 2004 were correctly treated as a filing under 35 U.S.C. 111(a).

A review of the application file, and specifically the present petition, reveals that applicant has not provided any showing of sufficient cause (i.e., the loss of patent rights, the lack of an alternative remedy) that would justify the conversion of the present application, which has been properly processed as an application filed under 35 U.S.C. 111(a), to a national stage application filed under 35 U.S.C. 371. For example, as an alternative remedy, applicants may still file a proper national stage of PCT/US02/11104, accompanied by a petition for revival of the application under 37 CFR 1.137(b), and obtain the U.S. national stage application that was purportedly intended here.¹

¹ It is noted that, pursuant to 35 U.S.C. 371(d) and 37 CFR 1.495(h), the international application became abandoned with respect to the United States on 17 February 2004 based on applicants' failure to pay the basic national fee within thirty months of the priority date. The date of abandonment is more than seven months prior to applicants' September 22, 2004 filing. Thus, even if the September 22, 2004 submission had been a proper filing under 35 U.S.C. 371, a petition for revival would have been necessary before the national stage application could be processed.

Based on the above, the application papers filed September 22, 2004 were properly processed under 35 U.S.C. 111(a), the international application had become abandoned with respect to the United States months before the September 22, 2004 submission, and applicants have failed to demonstrate sufficient cause which would justify a conversion. On this record, granting of a petition to convert the application to a filing under 35 U.S.C 371 is not appropriate.

CONCLUSION

The petition to convert the application to a filing under 35 U.S.C. 371 is **DISMISSED** without prejudice. The present application will continue to be treated as a filing under 35 U.S.C. 111(a) and 37 CFR 1.53(b).

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration should include a cover letter entitled "Renewed Petition Under 37 CFR 1.182" and must include a showing of sufficient cause to justify the requested conversion, as discussed above.

Please direct further correspondence with respect to this petition to Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

The present application is being referred to the Office Of Initial Patent Examination for further processing in accordance with this decision.



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